

Application No. 09/ 778,165

Applicants: Marc Husemann et al.

Amendment in Response to Office Action dated October 23, 2003

REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants wish to address the showing required under 37 CFR §1.116(a) regarding why the amendment above is necessary and was not presented earlier. The amendment above is necessary to overcome the prior art rejections. In this regard, the thrust of the Examiner's rejections appears to be that polymer mixtures, as presently claimed, containing simple alcohols containing pendant "hydroxyl groups" are anticipated by and are obvious over the cited references. Accordingly, by amending claim 1 to require alcohols containing either (1) tert-butoxycarbonyl groups or (2) alcohols containing both tert-butoxycarbonyl groups and hydroxyl groups, Applicants believe that this amendment should remove the prior art rejections. The amendment was not presented earlier because the amendment is responsive to a new ground of rejection made for the first time in the final rejection and since this is the first substantive response to the final rejection, obviously the amendment above could not have been presented earlier.

Claims 1-8, 11 and 12 are pending. Examiner has indicated claims 3-8 contain allowable subject matter. Amendments have been made to claim 1 in response to the rejections under 35 U.S.C. 102 and 35 U.S.C. 103, wherein the alternative language "and/or" has been replaced to require now the tert-butoxycarbonyl alone or combination with the hydroxyl groups, and to

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eliminate acrylates and/or methacrylates whose alcohol component contains only hydroxyl groups. Further amendments have been made to claim 1 for sake of clarity. Changes that have been made to the claims are presented above using strikethrough and underlining. It is believed that no new matter has been added.

Rejections under 35 U.S.C. 102

The Examiner rejected claims 1, 2, 11 and 12 under 35 U.S.C. 102(b) as being anticipated by Skinner et al. (U.S. Patent No. 4,128,600). According to the Examiner, Skinner teaches interpenetrating dual cure resins comprising a polyacrylate having hydroxyl functional groups, a polyisocyanate, and a photoinitiator that forms a urethane linked copolymer. In response, Applicants submit Skinner contains no teaching of a polyacrylate obtained by thermal crosslinking of a polymer mixture comprising a polyacrylate copolymer having acrylates and/or methacrylates whose alcohol component contains "tert-butoxycarbonyl (BOC) or a combination of tert-butoxycarbonyl (BOC) and hydroxyl groups". Skinner contains no teaching of BOC protecting groups, but rather of hydroxyl functional groups alone.

The Examiner has already indicated the lack of teaching thereof in her explanation of the allowable subject matter found at page 3 of the Office Action, wherein she recites:

The prior art cited herein and otherwise known to the examiner does not disclose or suggest polyacrylate copolymer obtained from 1-20% by weight (meth)acrylate monomers containing tert-butoxycarbonyl groups in combination with a polymerization regulating photoinitiator and 0.1 to 5% by

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weight of a difunctional isocyanate and/or a bifunctional epoxide.

Accordingly, because Skinner contains no teaching of a polyacrylate obtained from a thermal crosslinking of a polymer mixture comprising acrylates and/or methacrylates whose alcohol component contains "tert-butoxycarbonyl (BOC) or a combination of tert-butoxycarbonyl (BOC) and hydroxyl groups", Applicants submit the claims are not anticipated by Skinner.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejections under 35 U.S.C. 103

Claims 1, 2, 11 and 12 stand rejected under 35 U.S.C. 103(a) as being obvious over Karim et al. (U.S. Patent No. 5,721,289). According to the Examiner, Karim teaches products obtained by cross-linking composition comprising a polyacrylate and a cationically polymerizable monomer in the presence of a photoinitiator. The Examiner ultimately found it would have been obvious to employ the polyacrylate having hydroxyl groups in Karim to obtain the presently claimed invention. In response, Applicants submit a person skilled in the art would not have been led to the present invention, because there is no suggestion or motivation for a polyacrylate obtained from a thermal crosslinking of a polymer mixture comprising acrylates and/or methacrylates whose alcohol component contains "tert-butoxycarbonyl (BOC) or a combination of tert-butoxycarbonyl (BOC) and hydroxyl groups". Karim makes no suggestion of

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BOC protecting groups, and as the Examiner has pointed out, Karim refers to hydroxyl groups as they relate to the acrylate and/or methacrylate. Moreover, as stated above, the Examiner has already indicated that Karim, or any other prior art, does not suggest or teach the invention as is presently claimed. Wherefore, the claims are not rendered obvious by Karim.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

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Early and favorable action is earnestly solicited.

Respectfully submitted.

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (12 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 23 April 2004

By 
David D. Kim